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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte UDAY W. JOSHI and RICHARD MOULD

Appeal 2007-2442
Application 09/898,232
Technology Center 3600

Decided: April 14, 2008

Before JENNIFER D. BAHR, LINDA E. HORNER, and DAVID B. WALKER,
Administrative Patent Judges.

WALKER, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-7, 9, and 18-19. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We reverse.

Appellants claim a system and method for producing mail pieces for direct mail advertising utilizing a data center (Specification 1:4-6). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method for generating a mailing comprising the steps of:

storing at a data center a design for each of a plurality of mail pieces, each of said designs being in a format viewable from a remote computer via a network;

receiving, at said data center, an order for a plurality of pieces of a first mail piece design from said remote computer via said network;

combining, using a processor at said data center, said order for said plurality of pieces of said first mail piece design with at least one other order for a plurality of pieces of a second mail piece design to produce a single print run;

arranging, using said processor, said single print run in a presort sequence based on recipient addressing information for said plurality of pieces of said first and second mail piece design;

printing each of said plurality of pieces of said first mail piece design and said plurality of pieces of said second mail piece design of said single print run in said arranged presort sequence on a corresponding print medium to produce a plurality of finished mail pieces in said presort sequence; and

mailing said plurality of finished mail pieces.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

| | | |
|-------|--------------|--------------|
| Mori | US 5,982,994 | Nov. 9, 1999 |
| Fabel | US 6,209,779 | Apr. 3, 2001 |

The following rejections are before us for review.

1. Claims 1-2, 5, 9, and 18-19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Mori.
2. Claims 3-4, 6-7, and 9 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Mori in view of Fabel.

ISSUE

The issue before us is whether Appellants have shown that the Examiner erred in rejecting: 1) claims 1-2, 5, 9, and 18-19 under 35 U.S.C. § 103(a) as unpatentable over Mori; and 2) claim 3-4, 6-7, and 9 under 35 U.S.C. § 103(a) as unpatentable over Mori in view of Fabel. The dispositive issue is whether it would have been obvious to one of skill in the art to arrange, using a processor, a single print run (formed by combining an order for a plurality of pieces of a first mail piece design with at least one other order for a plurality of pieces of a second mail piece design) in a presort sequence based on recipient addressing information for said plurality of pieces of said first and second mail piece design.

Rather than repeat the arguments of Appellants and the Examiner, we make reference to the Brief and the Answer for their respective details. Only those

arguments actually made by Appellants have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2007).

FINDINGS OF FACT

We find the following enumerated findings to be supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Mori relates to a network printer apparatus and a LAN network system which provides a communication function and a full-scale server function between the network printer apparatus and a LAN by adding a LAN adapter portion to the printer apparatus itself (Mori, col. 1, ll. 10-17).
2. Mori teaches that the network printer apparatus has a printing function using a form overlay that permits printing an image on paper overlaid with the form which is stored in advance (Mori, col. 1, ll. 42-45). One object of Mori is to provide a network printing apparatus with a post-processing function for sorting printing jobs (printed sheets of paper) into the order of user or into the order of group, and a LAN network system comprising such a network printer apparatus (Mori, col. 4, ll. 14-19).
3. Mori discloses a mailbox provided with bins for accommodating printed paper so as to store printed paper in a designated bin and a storage means

- (hard disk) for storing printing data (SPOOL information), font, form overlay, account log information, mailbox control information files, etc. (Mori, col. 6, ll. 36-47). If the mailbox is provided, the mailbox controller obtains the number of the bin which is to store the printed paper directly or indirectly from the printing information, and store the printed paper in the bin (Mori, col. 7, ll. 1-4).
4. Mori teaches prioritizing or ordering print jobs based on 1) jobs with the same form overlay name and same emulation program; 2) jobs with a different emulation program but the same form overlay; and 3) jobs using a different form overlay but the same emulation program as the last print job (Mori, col. 7, l. 40 – col. 9, l. 6).
 5. Mori does not teach arranging, using a processor, a single print run (formed by combining an order for a plurality of pieces of a first mail piece design with at least one other order for a plurality of pieces of a second mail piece design) in a presort sequence based on recipient addressing information for said plurality of pieces of said first and second mail piece design.
 6. Fabel teaches a mailer blank having a return receipt post card which can be printed on both faces thereof by a single pass through a non-impact simplex printer (Fabel, abstract). Fabel describes printing fixed information, which does not vary from one mailer to another during the preparation of a batch of mailers, and variable information, which does vary from one mailer to another, on the inner paper layer of a mailer

- (Fabel, col. 9, ll. 6-10). Variable information is expected to be printed by a simplex, non-impact printer, such as a laser printer or an ink jet printer, whereas fixed information can be printed using the same non-impact printer or it may be preprinted during or after the manufacture of the mailer by normal commercial printing processes. It is possible for the fixed and variable information to be printed together during a single pass through the non-impact printer (Fabel, col. 9, ll. 16-25). Variable information includes at least a name and address (Fabel, col. 9, ll. 10-14). Fixed information may provide, for example, a return address, bulk mail permit information, and opening information (Fabel, col. 10, ll. 1-4).
7. Fabel does not teach arranging, using a processor, a single print run (formed by combining an order for a plurality of pieces of a first mail piece design with at least one other order for a plurality of pieces of a second mail piece design) in a presort sequence based on recipient addressing information for said plurality of pieces of said first and second mail piece.

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including

(1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of ordinary skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the appellant. *Id.* at 1445. *See also Piasecki*, 745 F.2d at 1472. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445; *Piasecki*, 745 F.2d at 1472.

ANALYSIS

- A. Rejection of claims 1-2, 5, 9, and 18-19 under 35 U.S.C. § 103(a) as unpatentable over Mori.

The Examiner found that Mori suggests “about arranging those single print runs in a presort sequence - Mori et al. teach in the abstract that printing jobs can be sorted out into the order of clients (e.g., using address/location as a base-line for sorting)” (Answer 4). We disagree. Mori teaches sorting print jobs into separate physical bins (one or more per client or group) (Findings of Fact 2-3). The only

sorting in terms of order of printing discussed is based on some combination of emulation program with which the print job was generated and form overlay with which the job is to be printed. Mori teaches grouping jobs with the same emulation program and/or form overlay to reduce lost time in changing between emulation programs and/or form overlays (Finding of Fact 4). Mori does not teach using a presort sequence based on recipient addressing information for a plurality of pieces of said first and second mail piece design as required by Claim 1 (Br. 7, Finding of Fact 5). We therefore reverse the rejection of claim 1, and claims 2, 5, and 9 which depend therefrom, because the Examiner has not made a prima facie case of obviousness of the claimed subject matter based on Mori.

Claim 18 is a system claim that has a similar limitation (Br. 9), specifically

said processor combining said order for said plurality of mail pieces having said first design with at least one other order for a plurality of pieces of a second design to produce a single print run and arranging said single print run in a presort sequence based on recipient addressing information for said plurality of pieces of said first and second mail piece design.

(emphasis added). We therefore also reverse the rejection of claim 18, and claim 19 which depends therefrom, because Mori does not teach this limitation, and the Examiner thus has not made a prima facie case of obviousness of the claimed subject matter based on Mori.

- B. Rejection of claims 3-4, 6-7, and 9 under 35 U.S.C. § 103(a) as unpatentable over Mori in view of Fabel.

Claims 3-4, 6-7, and 9 depend, directly or indirectly, from claim 1 and therefore contain the limitation that forms the basis on which we reverse the rejection of claim 1 over Mori alone. Fabel fails to remedy the deficiency of Mori, because it also does not teach arranging a single print run in a presort sequence based on recipient addressing information for said plurality of pieces of said first and second mail piece design (Br. 10, Finding of Fact 7). The Examiner thus has failed to make a prima facie case of obviousness of the subject matter of claims 3-4, 6-7, and 9 based on Mori in view of Fabel.

CONCLUSIONS

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1-7, 9 and 18-19 under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner to reject claims 1-7, 9, and 18-19 under 35 U.S.C. § 103(a) is reversed.

REVERSED

vsh

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Application 09/898,232

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